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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,350	10/29/2003	Tsuyoshi Uchara	021311B	5977
23850	7590	05/03/2006	EXAMINER	
ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP			GREIMEL, JOCELYN	
1725 K STREET, NW			ART UNIT	
SUITE 1000			PAPER NUMBER	
WASHINGTON, DC 20006			3624	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding..

<b>Office Action Summary</b>	<b>Application No.</b> 10/695,350	<b>Applicant(s)</b> UEHARA ET AL.	
	<b>Examiner</b> Jocelyn W. Greimel	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 1-6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>see attachment</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

Information Disclosure Statements: 10/29/2003, 07/27/2004, 10/29/2003

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1-6 are objected to because of the following informalities. The use of "characterized in comprising" in the claims is vague. For example in lines 10-13 on page 94, a recommended change would be to remove "characterized in comprising the steps that" and use "the server system comprising."

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-6 are rejected under 35 U.S.C. 102 as being unpatentable over Kitchen et al, US Patent No. 6,289,322 (hereinafter Kitchen).

3. In reference to claims 1, 5 and 6, Kitchen discloses a method for managing transactions and settlements, which can be associated with an identification code or specific bill presentment information, with a supplier system, used by a supplier for issuing electronic invoices; a buyer system used by a buyer for receiving electronic invoices (col. 4, lines 11-35); a finance system for managing a bank account of the supplier and a bank account of the buyer and for performing a deposit/withdrawal processing of the bank accounts (col. 8, lines 46-67); a server system communicably

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connected to the supplier system, buyer system and finance system through a communications network (col. 4, lines 36-55).

4. Additionally, in regard to claims 1, 5 and 6, Kitchen teaches the server system receiving electronic invoices from the supplier system to register the invoices into a specified database; the server system or buyer system receives a payment request for the electronic invoices from the buyer; the server system receives a notification of deposit/withdrawal processing acknowledging that the deposit/withdrawal processing for the electronic invoices had been performed or a deposit/withdrawal statement based on a result of the deposit/withdrawal processing, from the finance system (col. 4, lines 11-35; col. 4, lines 36-55).

5. Further, in regard to claims 1, 5 and 6, Kitchen teaches the server system managing the status of the registered electronic invoices by updating the status of the electronic invoices in response to the payment request issued from the buyer as well as to the notification of deposit/withdrawal processing or the deposit/withdrawal statement issued from the finance system and the server system notifies the supplier system of the status of the managed electronic invoices (col. 4, lines 11-35).

6. Regarding claims 2 and 4, Kitchen teaches the server system notifying the buyer system or finance system of the managed status of the electronic invoices (col. 4, lines 11-35) and the server system providing the supplier system, buyer system or finance system with a screen displaying the status of a plurality of the electronic invoices on a list (col. 3, lines 16-67 – col. 4, lines 1-67 – col. 5, lines 1-6).

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7. Regarding claim 3, Kitchen discloses a server system sending a screen to the buyer system for showing the buyer the content of the electronic invoices in the specified database, and for having the buyer input the payment request for the electronic invoices, and causes the buyer system to display the screen; the server system or buyer system (col. 4, lines 11-63), responding to the payment request for the electronic invoices inputted by the buyer to the screen displayed by the buyer system, regarding the displayed electronic invoices, receives the buyer's payment request to prepare and send the electronic payment request for the electronic invoices to the finance system; and the server system, in response to the electronic payment request has been sent to the finance system (col. 8, lines 46-67), updates the status of the electronic invoices when the payment request is in progress and sends the payment-request-in-progress to the supplier system (col. 4, lines 11-55).

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and 10-13 of copending Application No. 10/694,269. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims define the same method, server system and computer program for managing transactions and settlements in an electronic banking setting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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10. Additionally, claims 1-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7, 10 and 12 of copending Application No. 10/258,734. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims define the same method, server system and computer program for managing transactions and settlements in an electronic banking setting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn W. Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached Monday - Friday 8:30 AM - 4:30 PM EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jocelyn Greimel  
Examiner  
April 19, 2006

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HANI M. KAZIMI  
PRIMARY EXAMINER